FILED
SEP 21 1944
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1944.

No. 382

SELCHOW & RIGHTER COMPANY,
Petitioner,

vs.

WESTERN PRINTING & LITHOGRAPHING COMPANY and WHITMAN PUBLISHING COMPANY,
Respondents.

PETITIONER'S REPLY TO RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

ROSS O. HINKLE,
2300 Board of Trade Bldg.,
Chicago 4, Illinois,
Attorney for Petitioner.

LEON F. SHACKELL,
Of Counsel.

MC CORMICK AND HENDERSON, INC., CHICAGO

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To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Respondents' brief in opposition to Petitioner's Petition for Writ of Certiorari fails to point out wherein a single reason relied upon for the allowance of the writ is not presented by the case at bar. Nowhere in respondents' brief are the "Questions Presented" by the Petition even alluded to; nowhere is it even hinted that they are not

presented by the case at bar or that they are not sufficiently important to warrant this Court's review.

I.

Respondents, although agreeing with petitioner's Propositions (1) "that under a registration pursuant to the Act of 1905 all questions involved in an action for infringement * * * are federal questions" and (2) that "the court below should have applied the statutory tests of infringement," attempt to dismiss the subject and base their opposition almost entirely upon their unsupported statement that "The opinions below make it clear that the Federal law was applied."

On the contrary, we say that the opinions of the courts below make it clear that both applied tests of "the old common law rules of unfair competition" and purported to extend to the plaintiff-petitioner only such protection as was afforded "under the common law," notwithstanding the fact that a valid federal trade-mark registration under the Act of 1905 was involved.

The words just quoted were taken verbatim from the opinion of the Circuit Court of Appeals, and we submit it is proper to assume that that court meant what it said and also had in mind that this Court said in *Erie Railroad Co.* v. *Tompkins*, 304 U. S. 64: "There is no federal general common law."

Consequently we submit that it was proper to consider that the Circuit Court of Appeals applied, as it said it did, principles of common or local law whereas (in accord with respondents' counsel) we say the courts below should have applied federal statutory law.

Surely, then, there is here presented an important question which this Court should decide, which it intended to decide in *Pecheur Lozenge Co.* v. *National Candy Co.*, 315

U. S. 666, but which it was there precluded from deciding because "the suit was not founded upon a trade-mark registered under the 1905 Act, as the bill of complaint had made it appear."

Furthermore, the application by the court below of "tests applicable" under "the old common law" brings it into direct conflict with its own decision in *Philco Corp.* v. *Phillips Mfg. Co.*, 133 F. (2d) 663, with the decision of this Court in *Sola Electric Co.* v. *Jefferson Electric Co.*, 317 U. S. 173, and with the decision of the Second Circuit Court of Appeals in *Dwinell-Wright Co.* v. *National Fruit Product Co.*, 140 F. (2d) 618.

II.

The decision of the court below conflicts, in at least three vital respects, with the controlling decision of this Court in *Thaddeus Davids Co.* v. *Davids*, 233 U. S. 416.

1. The court below said that "the applicable tests in this case were the old common law rules of unfair competition"; whereas this Court said in the *Davids* case, at page 471 of 233 U. S.:

> "* * * This is not to say that, in this view, the case becomes one simply of unfair competition, as that category has been defined in the law; for, whatever analogy may exist with respect to the scope of protection in this class of cases, still the right to be protected against an unwarranted use of the registered mark has been made a statutory right, * * *." (Pet. Br. pp. 22-23.)

2. The court below approved the ruling of the District Court that petitioner (plaintiff-appellant below) must make an affirmative showing that its trade-mark "Parcheesi" had acquired a secondary meaning; whereas in the *Davids* case, without any reference to whether proof had been adduced to show acquisition of a secondary meaning by the surname "Davids", — which had been registered under the ten-year proviso of the Act of 1905, — this Court, with reference to marks so registered, said at page 470 of 233 U. S., that

> "* * * Their exclusive use as trademarks for the stated period was deemed, in the judgment of Congress, a sufficient assurance that they had acquired a secondary meaning as the designation of the origin or ownership of the merchandise to which they were affixed. * * *" (Pet. Br. pp. 21-22.)

3. Both courts below held petitioner's federal registration of its trade-mark "Parcheesi" to be valid and not abandoned; yet, in denying to petitioner the protection to which, — as this Court said in the *Davids* case, at page 469 of 233 U. S. — petitioner is entitled on due registration, the courts below did not even hint that they had considered the question whether or not respondents' red game of "Whitman's Pachisi" was a "reproduction, counterfeit, copy or colorable imitation" of "Parcheesi" within the meaning of Section 16 of the Act of 1905, as construed in the *Davids* case (Pet. Br. pp. 21 (first paragraph), 23-24).

Respectfully submitted,

Ross O. Hinkle,
2300 Board of Trade Bldg.,
Chicago 4, Illinois
Attorney for Petitioner.

Leon F. Shackell,
Of Counsel.